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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,983	02/25/2004	Masaki Tonomura	826.1929	8965
21171 7590 12/18/2006 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER VO, HIEN XUAN	
			ART UNIT	PAPER NUMBER
			2863	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/18/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/784,983	TONOMURA ET AL.	
	Examiner	Art Unit	
	Hien X. Vo	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims 5-16 are drawn to a computer program per se. A computer program per se is abstract instructions. Therefor, a computer program is not a physical thing (product) nor a process as they are not "acts" being performed. As such these claims are not directed to one of the statutory categories of invention (see MPEP 2106.01), but are directed to nonstatutory functional descriptive material.

It is noted that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2863

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-11 rejected under 35 U.S.C. 103(a) as being unpatentable over

Weinberg et al. (U.S. Patent No. 6,587,969) further in view of Nelson et al. (U.S. Patent No. 6,507,861).

With respect to claim 1, Weinberg et al. disclose the software system and methods for testing the functionality of a transactional server including an electronic text parsing unit parsing an electronic text transmitted from a program to be tested to detect a required data item (see e.g. Figs. 6A-7 and col. 21, lines 10-13); and an electronic text data setting unit embedding an input data value, which corresponds to the detected data item, in an electronic text to be transmitted to a side of the program to be tested (see e.g. Figs. 3A-5F and col. 13, lines 30-67), except for teaching wherein a stub-call unit to invoke the stub apparatus is provided in the program to be tested. However, Nelson et al disclose a system and method for avoiding deadlock in a non-preemptive multi-threaded application running in a non-preemptive multi-tasking environment including a stub-call unit to invoke the stub apparatus is provided in the program to be tested (see e.g. Fig. 4, col. 3, lines 58-67 and col. 8, lines 30-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Weinberg to have use of a stub-call unit in the program to be tested as taught by Nelson in order to have a maximum background processing in a multi-tasking operation system.

With respect to claims 2-4, Weinberg et al. disclose the invention as claimed including a setting screen generating unit generating a data setting screen for receiving the input data value, which corresponds to the detected data item, and giving the set value said electronic text data setting unit (see e.g. Figs. 2-5F); an input value generating unit automatically generating input data in correspondence with the data item detected by said electronic text parsing unit, and giving the generated input data to said setting screen generating unit (see e.g. col. 3, lines 11-28), an electronic text data storing unit storing the set data value embedded by said electronic text data setting unit (see e.g. col. 15, lines 15-34); and an electronic text data reading unit reading the data stored in said electronic text data storing unit, and giving the read data to the setting screen generating unit as the input data (see e.g. col. 21, lines 8-21).

With respect to claims 5-11, the limitations of these claims have been noted in the rejection above. They are therefore consider rejected as set forth above.

2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien X. Vo whose telephone number is (571) 272-2282. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2863

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hien Vo
12/11/06



John Barlow
Supervisory Patent Examiner
Technology Center 2800